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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

080839-0380626

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Application Number

09/990,625

Filed

November 20, 2001

First Named Inventor

Scott Montgomery, et al.

Art Unit

3628

Examiner

Akiba K. Robinson Boyce

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

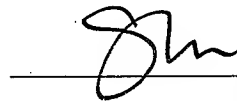
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 58,780

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____



Signature

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Typed or printed name

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Telephone number

August 13, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANTS: Scott MONTGOMERY et al. CONFIRMATION No. : 3428
SERIAL NUMBER : 09/990,625 EXAMINER : Akiba K. Robinson Boyce
FILING DATE : November 20, 2001 ART UNIT : 3628
FOR : AUDITABLE AND SECURE SYSTEMS AND METHODS FOR ISSUING REFUNDS FOR MISPRINTS OF
MAIL PIECES

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In response to the Final Office Action mailed **May 13, 2010** (hereinafter "Final Action") in the above-referenced application, Appellants hereby request review of the Final Action for at least the reasons set forth herein. This request, which is being filed concurrently with a Notice of Appeal, has a total of 5 pages.

It is believed that no extensions of time or other fees are due beyond those otherwise provided for in documents accompanying this paper. However, if additional extensions of time or other fees are determined to be due, the Director is authorized to charge the same to our Deposit Account No. 033975 (Ref. No. 080839-0380626).

REJECTION UNDER 35 U.S.C. § 103

The Examiner has rejected claims 1, 3-6, 8-9, 12-24, 26-28, 30-38, 40-42, 44-45, 48, and 55-56 under 35 U.S.C. § 103 as allegedly being unpatentable over U.S. Patent No. 6,547,136 to Sansone ("Sansone") in view of U.S. Patent No. 6,527,178 to Gordon et al. ("Gordon") and U.S. Patent No. 6,005,945 to Whitehouse ("Whitehouse").¹ In addition, the Examiner has rejected claim 29 under 35 U.S.C. § 103 as allegedly being unpatentable over Sansone in view of Gordon, Whitehouse, and U.S. Patent No. 5,008,827 to Sansone et al. ("Sansone et al."). These rejections are improper and must be withdrawn for at least the following reasons.²

¹ The rejection heading incorrectly identifies Gordon as U.S. Patent No. 6,527,128 and erroneously omits claim 48.

² Appellants note that the rejection of claim 29 will not be addressed in substantial detail herein solely to expedite the Pre-Appeal Brief Review, as the rejection of claim 29 must fail at least because the rejection of independent claim 28, from which claim 29 depends, is improper. Nonetheless, Appellants note that the rejection of claim 29 is improper for additional reasons, and Appellants expressly reserve the right to present arguments addressing such reasons to the extent that this application eventually proceeds to the Board of Patent Appeals and Interferences.

A. THE EXAMINER HAS FAILED TO TREAT CLAIMS 35 AND 45 ON THE MERITS

At the outset, Appellants note that although the Examiner has indicated that claims 35 and 45 are rejected as allegedly being unpatentable over Sansone, Gordon, and Whitehouse (Final Action, page 2), the Examiner has not included any discussion of the alleged basis for the rejection with respect to claim 35 and 45. *See* Final Action, pages 3-35. Accordingly, the rejection is improper and must be withdrawn at least with respect to claims 35 and 45 because the Examiner has failed to provide any rationale for alleging that Sansone, Gordon, or Whitehouse, either alone or in combination, disclose, teach, or suggest the features recited therein.

B. SANSONE, GORDON, AND WHITEHOUSE FAIL TO DISCLOSE, TEACH, OR SUGGEST EACH AND EVERY FEATURE RECITED IN THE INDEPENDENT CLAIMS

More particularly, Sansone, Gordon, and Whitehouse, either alone or in combination, fail to disclose, teach, or suggest retrieving information that “includes *the delivery status* associated with the unique tracking identifier stored for *the postage purchase transaction* from the database in response to . . . a refund inquiry for *the postage purchase transaction*” and “refunding *the postage purchase transaction* based on *the delivery status* associated with the unique tracking identifier,” as recited in independent claim 1, for example. The Examiner alleges that Sansone discloses retrieving information stored for a postage transaction in response to a refund inquiry for a postage purchase transaction and refunding the postage purchase transaction based on the delivery status associated with a unique tracking identifier stored for the postage purchase transaction. Appellants disagree with the Examiner’s assessment for at least the reason that Sansone is unrelated to refunding a “*postage purchase transaction*,” much less to refunding a postage purchase transaction based on the delivery status associated with a unique tracking identifier stored for the postage purchase transaction.

Rather, Sansone generally relates to providing a “Merchandise Return Label” with postage that a seller of goods pre-pays, whereby a buyer can return the goods to the seller in a mail piece carrying the “Merchandise Return Label.” Although the Examiner concedes that Sansone indeed relates to a system that enables free shipping with a return of goods, the Examiner alleges that Sansone nonetheless discloses a “postage purchase transaction” because the system described in Sansone “computes the return postage, fees and total cost that are due for returning the goods.” However, in the scenarios described in Sansone where the Merchandise Return Label has return postage “paid for by the seller’s postage meter” (e.g., Abstract), the buyer cannot reasonably be characterized as receiving a refund for a transaction that includes purchasing the “return postage” because the seller, not the buyer, actually purchases the postage. In other words, the buyer cannot receive a refund for the postage on the “Merchandise Return Label” when the buyer did not purchase the postage. Consequently, where Sansone describes the seller pre-paying the return

postage to provide the buyer with free shipping when returning goods to the seller, Sansone fails to disclose, teach, or suggest “refunding [the buyer for] the postage purchase transaction,” as claimed, because the seller would be the only entity eligible to receive a refund for the transaction that resulted in purchasing the return postage.

Furthermore, to the extent that Sansone describes a particular scenario where the buyer “may be obligated to pay the postage and fees [due for returning the goods] in accordance with an agreement between the buyer and the seller” (col. 7, lines 38-65), Sansone nonetheless fails to disclose, teach, or suggest “refunding [the buyer for] the postage purchase transaction.” Rather, this particular scenario only appears to provide the seller with the ability to require the buyer to pay for the postage on the “Merchandise Return Label” that the buyer uses to return goods to the seller, but Sansone does not further disclose, teach, or suggest the seller refunding the buyer for the postage and fees purchased on the “Merchandise Return Label,” much less that refunding the buyer for such postage and fees “based on the delivery status associated with [a] unique tracking identifier” stored for the postage purchase transaction. For example, Sansone only describes the seller refunding the buyer for returned goods, whereby an amount refunded to the buyer for the returned goods may be reduced by the cost of the purchased postage and fees (e.g., col. 6, lines 19-54, describing “the manner in which **goods** are returned” without describing any techniques for refunding postage and fees due on the “Merchandise Return Label” used to return the goods). In other words, rather Sansone only describes techniques for enabling buyers to affix the “Merchandise Return Label” on a container with “the **goods** that are going to be returned to the seller,” whereby the buyer “will receive a refund via **returned goods process**” (col. 6, lines 19-54).

Moreover, even assuming that Sansone could be characterized as describing techniques whereby buyers can be refunded for goods shipped in packages that bear the “Merchandise Return Label,” Sansone does not disclose, teach, or suggest that the buyer receives the refund based on “based on the delivery status associated with [a] unique tracking identifier” stored for the postage purchase transaction. For example, the returned goods process described in Sansone includes determining whether “information in code 253 [on the “Merchandise Return Label”] matches the information sent to data base 262,” wherein the seller will receive the goods in the container carrying the “Merchandise Return Label” if the information in the code 253 and the information sent to the data base 262 match. On the other hand, if the information in the code 253 and the information sent to the data base 262 do not match, the “container 50 will be transferred to parcel buffer 261 for further processing” (col. 6, lines 19-54). Thus, at best, the returned goods process that Sansone describes determines whether to refund the buyer based on a comparison between information on the “Merchandise Return Label” and information sent to a database. In other words, because the buyer may be ineligible to receive a refund for returned goods even if a container carrying the “Merchandise Return Label” was properly delivered, Sansone does not

disclose, teach, or suggest refunding the buyer based on the “delivery status” associated with the container carrying the “Merchandise Return Label.”

To clarify the above distinctions over Sansone, Appellants refer to the features that independent claim 1 recites to determine whether or not to issue a refund for “a postage purchase transaction.” In particular, independent claim 1 recites, among other things, generating “a unique postage indicium in response to receiving a request for a postage purchase transaction, wherein the unique postage indicium contains a unique tracking identifier that provides a mail piece tracking capability within the United States Postal Service.” Thus, in response to “receiving a refund inquiry *for the postage purchase transaction*,” independent claim 1 further recites “retrieving [] information stored for the postage purchase transaction,” including “the delivery status associated with *the unique tracking identifier*,” and then “refund[ing] the postage purchase transaction *based on the delivery status associated with the unique tracking identifier*.” Furthermore, additional independent claims 15, 23, 28, 33, and 48 recite further context around how “refund[ing] the postage purchase transaction” may be based on the “delivery status.”³

Accordingly, for at least the reason that Sansone only describes refunding a buyer for returned goods rather than a “postage purchase transaction,” Sansone does not disclose, teach, or suggest at least the features that relate to “refund[ing] *the postage purchase transaction*.” Moreover, for at least the reason that Sansone only describes refunding the buyer for the returned goods based on a comparison between a code on a “Merchandise Return Label” and information in a database, wherein the comparison does not consider “the delivery status” associated with the information in the code on the “Merchandise Return Label,” Sansone further fails to disclose, teach, or suggest the features that relate to “refund[ing] the postage purchase transaction *based on the delivery status associated with the unique tracking identifier*.”

Gordon fails to cure the foregoing deficiencies of Sansone for at least the reason that the Examiner only relies upon Gordon as allegedly teaching generating a unique postage indicium in response to a requested postage purchase transaction. However, even assuming *arguendo* that the Examiner has correctly characterized Gordon (which Appellants do not concede), indexing a postage indicium with a serial or transaction number in and of itself does not disclose, teach, or suggest referencing the serial or transaction number to determine whether or not to refund a

³ See, e.g., independent claim 15 (refund[ing] a postage purchase transaction if the delivery status indicates that the USPS has not delivered a mail piece carrying a unique tracking identifier associated therewith and that a date for the postage transaction has the same date as another postage purchase transaction), independent claims 23, 28, and 33 (refund[ing] one of multiple duplicative postage purchase transactions if their respective delivery statuses indicate that the USPS has only delivered a mail piece carrying a unique tracking identifier associated with one of the duplicative postage purchase transactions), independent claim 48 (refund[ing] a postage purchase transaction if the delivery status indicates that the USPS has not delivered a mail piece carrying a unique tracking identifier associated therewith and subsequently checking for a change in the delivery status to ensure that a subsequently delivered mail piece does not carry the unique tracking identifier associated with the refunded postage purchase transaction).

transaction in which the postage indicium was purchased, much less to determining whether or not to refund the transaction based on a delivery status associated with the serial or transaction number. For at least these reasons, Gordon fails to cure the foregoing deficiencies of Sansone.

Whitehouse further fails to cure the foregoing deficiencies of Sansone and Gordon because Whitehouse does not describe refunding a postage purchase transaction based on the delivery status associated with "a unique tracking identifier" created in and stored for the transaction. Rather, Whitehouse generally describes refunding postage purchase transactions in scenarios where the USPS has not processed "an indicium with the date, meter number and serial number of the allegedly misprinted indicium" (col. 24, line 53 *et seq.*). However, independent claim 1 recites "a unique postage indicium" distinctly from "a unique tracking identifier" contained in the indicium. Thus, whereas independent claim 1 recites features that relate to refunding a postage purchase transaction based on a delivery status associated with "*the unique tracking identifier*," which provides a mail piece tracking capability in the USPS, Whitehouse describes techniques for refunding postage purchase transactions based on the status of the *postage indicium*. For at least these reasons, Whitehouse further fails to cure the foregoing deficiencies of Sansone and Gordon.

Accordingly, for at least the foregoing reasons, Sansone, Gordon, and Whitehouse, either alone or in combination, fail to disclose, teach, or suggest each and every feature of independent claim 1. Independent claims 15, 23, 28, 33, and 48 include features similar to those set forth in independent claim 1. Claims 3-6, 8-9, 12-14, 16-22, 24, 26-27, 29-32, 34-38, 40-42, 44-45, and 55-56 depend from and add features to one of independent claims 1, 15, 23, 28, 33, and 48. Thus, the rejections of these claims are improper and must be withdrawn for at least the foregoing reasons.

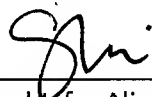
CONCLUSION

If personal communication will expedite prosecution of this application, for any reason, the Examiner is invited to telephone the undersigned at the number provided.

Date: **August 13, 2010**

Respectfully submitted,

By:



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